Appl. No. 09/438,856
Amdt. Dated 03/01/2006
Reply to Office Action of 09/01/2005

REMARKS

This is in response to the Office Action mailed on September 1, 2005. In the Office Action, (i) claims 6, 8-9, 15, 17-18, and 38-39 were objected for being dependent claims; (ii) claims 1-3, 10-12, 19-36, and 40-48 were rejected under 35 U.S.C. 103(a); and (iii) claims 7, 16, and 37 were indicated as being allowed.

Reexamination and reconsideration of this case is respectfully requested in view of the foregoing amendments and the following remarks.

Claims 1-3, 6-12, and 15-48 were previously pending. Claims 4-5 and 13-14 were previously cancelled without prejudice. No claim has been cancelled or added by this response. Claims 1, 6, and 15 have been amended. Accordingly, claims 1-3, 6-12, and 15-48 remain at issue. Of those at issue, claims 1, 6, 7, 10, 15, 16, 31, and 37 are independent claims.

Applicant believes that no new matter has been added by this response.

I.   Allowed Claims

In section 6, the Office Action indicated that claims 7, 16, and 37 are allowed.

Applicant respectfully thanks the Examiner for such indication.

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II. Information Disclosure Statement

Applicant filed an information disclosure statement (IDS) coincidentally with the filing of an RCE on 08/18/2004. Applicant has searched private PAIR and found that a copy of the IDS was indeed received by the USPTO. A copy of the 08/18/2004 IDS without the references is attached hereto as Appendix I.

Applicant did not receive a checked and signed Form 1449 with the Office Action mailed on 11/18/2004 or the Office Action mailed on 09/01/2005 indicating that the IDS filed on 08/18/2004 was considered.

For its records, Applicant respectfully requests a copy of the checked and signed Form 1449 for the IDS filed on 08/18/2004 with any further action mailed from the USPTO to be sure it has been considered.

III. Claim Objections

In sections 6.1 and 6.2, the Office Action objected to claims 6, 8-9, 15, 17-18, and 38-39 for being dependent on rejected base claims. The Office Action indicated that these claims would be allowable if rewritten into independent form including all the limitations of the independent claims and the intervening claims.

Applicant has amended claims 6 and 15 into independent form by including the limitations of independents claim 1 and 10 from which they previously depended. Claim 8-9 depend from independent claim 6. Claims 17-18 depend from independent claim 15. Applicant believes that these amendments to claims 6 and 15 now make this objection moot as to claims 6, 8-9, 15, and 17-18.

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Claims 38-39 remain dependent upon independent claim 31. From the remarks that follow below, Applicant respectfully believes that claim 31 is in condition for allowance such that claims 38-39 depending there-from with additional limitations are also in condition for allowance.

According, Applicant respectfully request the withdrawal of the objection to these claims.

IV.   Claim Rejections 35 U.S.C. 103

In section 5 of the Office Action, claims 1-3, 10-12, 19-36, and 40-48 were rejected under 35 U.S.C. 103(a) over U.S. Patent No. 5,446,676 issued to Huang et al. ("Huang") in view of U.S. Patent No. 5,278,769 issued to Bair et al. ("Bair").

Applicant respectfully traverses the 35 USC 103(a) claim rejections.

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)" [MPEP § 2142; 8th Edition, Rev. 3, August 2005, Pg. 2100-134].

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The Office Action alleges that Huang discloses:

"adding a first simulation routine to said SPICE netlist to perform a reference simulation of said SPICE netlist to arrive at nominal values for selected vector measurements (Figure 1 items 12, 14, 16 and 18 and Col. 4 line 47 "AS shown in FIG. 1, circuits formatted in a foreign netlist format 10 such as the SPICE (S-P-I-C-E) format should be translated into a native format for simulator 22. Spice2t." and then Col. 4 line 61, "Aliasfile 16 contains aliases for specified nodes in the SPICE netlist. During translation, names in the SPICE netlist referenced in the aliasfile 16 are converted to the alternate name specified in the aliasfile." And Figure 8 items 202. 204, 206, 208),"

"adding a perturbing routine to said SPICE netlist for altering circuit parameter values of said circuit design in a pre-determined manner; (Figure 8 item 212, Figure 1 item 34, Figure 9 item 133 "TRANSISTOR PARAMETER RECORD n" and Col. 5 line 2 "Stimulus file 34 contains input data used to stimulate the simulated circuit in simulator 22. The data or stimuli contained in file 34 may be in a variety of formats, including conventional test vectors, simulated clock input, constant period w r stimulus specification (stimulus signals to be applied at fixed time intervals) and logical one and zero constants."),"

"adding a second simulation routine to said SPICE netlist for performing simulations of said circuit design for respective altered circuit parameter values to arrive at respective selected vector measurements; and (Figure 1 item 26, 30 and 22 and Table 1, and Col. 9 line 10; "At Vs=O(zero), Vt=VTO, which

is a SPICE parameter defined for any transistor model. This
value may be adjusted by control file 24 parameter threholdmos
(item 9 of Table 1.)"),"

        and

        "adding an analysis routine to said SPICE netlist
for manipulating at least one of said selected vector
measurements in accordance with said predetermined analysis
(Figure 1 item 34 and Col. 13 line 50 "In addition to test
vectors, this file contains initialization vectors to set the
simulated circuit to a predefined state prior to beginning
actual simulation")"

        Applicant respectfully disagrees.

        The cited sections in Huang for allegedly disclosing
"adding a first simulation routine to said SPICE netlist to
perform a reference simulation of said SPICE netlist to arrive
at nominal values for selected vector measurements" describe
nothing more than a netlist conversion. Huang doesn't disclose
here "perform[ing] a reference simulation of said SPICE netlist
to arrive at nominal values for selected vector measurements" as
is recited in the claims.

        Moreover as discussed in Applicant's specification, "the
user sets the desired vector measurements for the simulation
template analysis. This can be, for example, a voltage at a
particular node, current along a particular branch, and/or the
power dissipation across a particular component."
[Specification, page 6, line 31 to page 7, line 2].

        The cited sections in Huang for allegedly disclosing
"adding a perturbing routine to said SPICE netlist for altering

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circuit parameter values of said circuit design in a pre-
determined manner" are nothing more than the description of an
input data file or stimulus file. It does not disclose
"altering **circuit parameter values** of said circuit design" as is
recited in the claim. (emphasis added).

For example, <u>Huang</u> doesn't disclose modifying a netlist "to
include tolerance information" for resistance or capacitance of
respective resistors or capacitors as is disclosed in
Applicant's specification. [Specification, page 11, lines 6-9].
<u>Huang</u> doesn't disclose adding "routines for varying the
parameter values within the tolerance limits" as disclosed in
Applicant's specification. [Specification, page 7, line 24].

The cited sections in <u>Huang</u> for allegedly disclosing
"adding a second simulation routine to said SPICE netlist for
performing simulations of said circuit design for respective
altered circuit parameter values to arrive at respective
selected vector measurements" describe computing the "threshold
voltage of a transistor as a function of the body bias voltage".
[<u>Huang</u>, Col. 9, lines 4-5, and <u>Huang</u>'s equation (7)]. This does
not disclose "adding a second simulation routine to said SPICE
netlist for performing simulations of said circuit design for
respective altered circuit parameter values to arrive at
respective selected vector measurements" as is recited in the
claims.

The cited sections in <u>Huang</u> for allegedly disclosing
"adding an analysis routine to said SPICE netlist for

manipulating at least one of said selected vector measurements
in accordance with said predetermined analysis" only describe
setting "the simulated circuit to a predefined state prior to
beginning actual simulation" through the use of initialization
vectors for an event-driven simulation. [Huang Col. 13, lines
51-52]. Huang does not describe any sort of analysis here of
any selected vector measurement.

The Office Action admits that the Huang "reference does not
expressly disclose the use of simulation Templates." Instead
the Office Action alleges that the Bair "reference discloses the
use of simulation templates (Figure 10 and Col. 7 lines 44-46)."
Applicant respectfully disagrees.

As is more fully discussed in Bair's detailed description,
Bair's "FIG. 10 is a listing of a logic simulator model source
file (i.e., 230 with respect to FIG. 2) listing the appropriate
delays, primitives, and timing relationships between pins. These
results were derived from the auto-model generator (i.e., 226
with respect to FIG. 2)." This corresponds to Bair's circuit
schematic of BSCN2_VRL illustrated in Bair's Figure 11. Bair
only describes this as a template because the "layout-related
parameters (capacitances) have not been supplied". [Bair, Col.
7, lines 45-46].

Thus for at least the forgoing reasons, the combination of
Huang and Bair do not make Applicant's rejected independent
claims 1, 10, and 31 obvious.

Regarding dependent claims 3 and 12, section 5.10 of the Office Action used the legal precedent of "eliminating element" discussed in MPEP §2144.04(II)(A) to reject dependent claims 3 and 12.

If the facts in a prior legal decision are not similar to those in an application under examination, the examiner may not use the rationale used by the court. [MPEP § 2144.04, 8th Edition, Rev. 3, August 2005; page 2100-144].

The cited legal precedent for omission of an element and its function in MPEP §2144.04(II)(A.) is *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989). Applicant previously provided a copy of the decision in Ex Parte Wu.

The claims and application in *Ex parte Wu* were "directed to a process for using a particular composition to inhibit corrosion on a metal surface." [*Ex parte Wu*, 10 USPQ 2031 at 2032 (Bd. Pat. App. & Inter. 1989)]. **Patentability in Ex parte Wu turned on the material composition and the claim language "consisting of" that excluded other elements from being a part of the claimed material composition.** (emphasis added) **The material composition of the prior art reference in Ex parte Wu disclosed all of the elements of the claimed material composition but with additional elements.** (emphasis added) **The court found that omitting the additional elements in the material composition of the prior art reference was obvious.** (emphasis added)

The *Ex parte Wu* claims were directed to material compositions by reciting a "method of decreasing corrosion rate by contacting a metal surface with a material composition

consisting of" in the chemical or material science arts. Ex
parte Wu claims did not involve claims directed to a computer
readable medium or a method of modifying a SPICE netlist for a
software simulator in the general field of computer programming.

Moreover, **Applicant's claims 3 and 12 do not recite the
limitation "consisting of" in order to exclude other elements
from a set of elements**. (emphasis added) **Applicant's claims 3
and 12 recite an additional step** of "removing parameter and
vector save statements in said SPICE netlist". (emphasis added)
[Claims 3, 12 as amended, lines 2-3]. This conserves "memory
space since a vector measurement may comprise large amounts of
data, which would require a substantial memory size if numerous
simulations are performed in the simulation template analysis."
[Specification, page 8, lines 7-9].

Additionally, **the Office Action does not properly apply the
legal precedent to exclude an element found in the prior art
reference of <u>Bair</u>**. (emphasis added) **In *Ex Parte Wu*, an element
found in the material composition of the prior art reference was
excluded in order to make the claims obvious.** (emphasis added)
A prior Office Action admitted that **<u>Bair</u> "does not expressly
disclose the additional limitation."** [Final Office Action, page
9, section 66, line 1]. **As <u>Bair</u> does not disclose an additional
limitation that is supposed to be excluded by Applicant's
claims, there is no reason to apply the legal precedent set
forth by *Ex Parte Wu*.** (emphasis added).

The Office Action has failed to find Applicant's additional
limitation in a prior art reference.

This Office Action states that "there are no unexpected
results from this admission so that MPEP 2144.04(II)(B) does not
apply." Applicant has not argued that there was an unexpected

result. Applicant has consistently argued that the facts
surrounding the legal precedent are not similar to those in this
case.

Applicant respectfully submits that the facts of *Ex parte
Wu* are not sufficiently similar to the facts in Applicant's
patent application and Applicant's claims.

For the foregoing reasons, Applicant respectfully submits
that the Examiner cannot rely on the legal precedent
(eliminating element) of *Ex parte Wu* to reject Applicant's
claims 3 and 12.

Moreover, rejected dependent claims 2-3, 19-24, 40-42
depend directly or indirectly from independent claim 1.
Rejected dependent claims 11-12, 25-30, 43-45 depend directly or
indirectly from independent claim 10. Rejected dependent claims
32-36, 46-48 and objected dependent claims 38-39 depend directly
or indirectly from independent claim 31.

Applicant believes that it has placed independent claims 1,
10, and 31 in condition for allowance such that dependent claims
depending there-from with added limitations are also in
condition for allowance.

Accordingly, Applicant respectfully requests the withdrawal
of the 35 USC § 103(a) claim rejections of claims 1-3, 10-12,
19-36, and 40-48.

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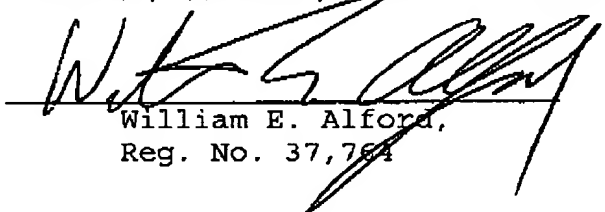Reply to Office Action of 09/01/2005

CONCLUSION

In view of the foregoing it is respectfully submitted that the pending claims are in condition for allowance. Reconsideration is requested. Allowance of the claims at an early date is solicited.

The Examiner is invited to contact Applicant's undersigned counsel by telephone at (714) 557-3800 to expedite the prosecution of this case should there be any unresolved matters remaining. Please charge any shortage in fees in connection with the filing of this paper to Deposit Account 02-2666 and please credit any excess fees to such deposit account.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: March 1, 2006

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CERTIFICATE OF FACSIMILE TRANSMISSION
I hereby certify that this correspondence is being transmitted via facsimile to the Patent and Trademark Office under 37 CFR §1.8 on: March 1, 2006 to Examiner
Dwin M. Craig at (571) 273-8300.

_____   3/1/2006
Colette Angle   Date

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Appl. No. 09/438,856
Amdt. Dated 03/01/2006
Reply to Office Action of 09/01/2005

Appendix I
Information Disclosure Statement
08/18/2004

Attny No. 003104.P002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

LAWRENCE G. MEARES

Application No.: 09/438,856

Filed: November 12, 1999

For:　**SYSTEM AND METHOD OF PROVIDING ADDITIONAL CIRCUIT ANALYSIS USING SIMULATION TEMPLATES**

Art Group: 2123

Examiner:　Eduardo Garcia-Otero

INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. §1.97

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the duty of disclosure, enclosed is a copy of Information Disclosure Statement by Applicant (form PTO/SB/08), which is being submitted concurrently with the Request for Continued Examination. It is respectfully requested that the cited references be considered and that the enclosed copy of PTO/SB/08 be initialed by the Examiner to indicate such consideration and a copy thereof returned to applicant(s).
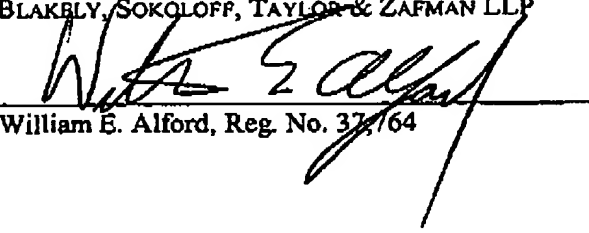
The submission of this Information Disclosure Statement is not to be construed as a representation that a search has been made in the subject application and is not to be construed as an admission that the information cited in this statement is material to patentability.

Please charge any fees due to Deposit Account 02-2666. A duplicate copy of the Fee Transmittal (PTO/SB/17) is enclosed for this purpose.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: August 18, 2004

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I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Pat Sullivan   08-18-04

Pat Sullivan   *Date*

-2-   3104P002

OIPE

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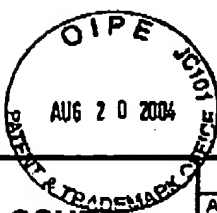
Substitute for form 1449A/PTO					*Complete If Known*	
INFORMATION DISCLOSURE **STATEMENT BY APPLICANT**				Application Number	09/438,856	
				Filing Date	November 12, 1999	
				First Named Inventor	Lawrence G. Meares	
				Art Unit	2123	
				Examiner Name	Eduardo Garcia-Otero	
Sheet	1	**of**	1	Attorney Docket Number	3104P002	

NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No.¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T²
		STEVEN M. SANDLER, "SMPS Simulation With Spice," McGraw Hill, 1997, (entire book) pages 1-187	
		LAWRENCE G. MEARES, CHARLES E. HYMOWITZ, "Simulating With Spice," Intusoft, San Pedro, CA, 1988, (entire book) pages 1-1 through 6-22 including appendix and index	

Examiner Signature		Date Considered	

*Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication.

¹Applicant's unique citation designation number. ²Applicant is to place a check mark here if English language Translation is attached.

Based on PTO/SB/08B (08-03) as modified by Blakely, Sokoloff, Taylor & Zafman (wr) 08/11/2003.
Send To: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450